

REMARKS

At the time of the Second Office Action dated November 21, 2007, claims 1-17 were pending and rejected in this application.

CLAIMS 1, 3, 6, 8-9, 11, 14, AND 16-17 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON BEN-SHAUL ET AL., U.S. PATENT NO. 6,976,090 (HEREINAFTER BEN-SHAUL)

On pages 4 and 5 of the Second Office Action, the Examiner asserted that Ben-Shaul discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

On pages 2-4 of the Request for Reconsideration dated September 12, 2007, Applicants presented extensive arguments as to why Applicants believe the Examiner has failed to establish a prima facie case of anticipation. The Examiner's response to these arguments is found on pages 2 and 3 of the Second Office Action. Initially, the Examiner asserted:

Applicant is correct that Examiner must explain his reasoning in regards to the applied references. However, it is not the duty of the examiner to map the claim limitations to the prior art. Instead, it is up to the applicant to at least make a good faith attempt to view the art as a whole, including portions not cited by the examiner. See MPEP 706 and 707. See also MPEP 2123 and 2183.

The Examiner appears to misunderstand the purpose of the Examiner's role in preparing an Office Action, which is not simply to set forth various passages within the applied prior art the Examiner is relying on to reject the claims. Instead, the purpose of an Office Action is to initiate (or continue) a dialogue, on the record, with Applicants regarding the Examiner's analysis that has led the Examiner to rejecting the claims.

As stated in M.P.E.P. § 706.06:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

Citing certain passages in the applied prior art is just a portion of "clearly [articulating] any rejection." How the Examiner is construing the claims (i.e., claim construction) is an important aspect during prosecution as it allows Applicants to either agree or disagree with the Examiner's claim construction and/or allow Applicants to amend claim language that the Examiner is interpreting broader than intended by Applicants. However, where the Examiner does not provide this claim construction, either explicitly or implicitly (i.e., by alleging that a certain specific teaching within the prior art identically discloses certain specific limitations), Applicants cannot "reply completely at the earliest opportunity."

Moreover, upon the Examiner not "mapping" specific alleged teachings in the prior art to specific claimed limitations, Applicants cannot know whether or not the Examiner has omitted certain claimed limitations and/or relied upon teachings that to do identically disclose the claimed limitations. Again, without this information, Applicants are left guessing as to the Examiner's analysis.

Moreover, notwithstanding that "patents are relevant as prior art for all they contain," (i.e., the Examiner's citation to M.P.E.P. § 2123), the Examiner must still meet the requirements of 37 C.F.R. § 1.104(c). The discussion in M.P.E.P. § 2123 merely states that the Examiner is not precluded from relying on all the teachings of the applied prior art. This section of the M.P.E.P., however, does not address the Examiner's burden in establishing a *prima facie* case of anticipation or obviousness.

Applicants are also entirely unclear as to the Examiner's reliance upon M.P.E.P. § 2183, which is directed to making a *prima facie* case of equivalence. Not only has the Examiner not made a *prima facie* case of equivalence as to any of the claimed limitations in either the First or Second Office Actions, the Examiner has not even alleged making a *prima facie* case of equivalence. Thus, the Examiner's citation of M.P.E.P. § 2183 appears to be irrelevant to the present application.

In the fifth enumerated paragraph spanning pages 2 and 3 of the Second Office Action, the Examiner further asserted the following:

Applicant makes particular focus on the length of quoted sections. The length of cited areas are not dispositive, particularly in cases where they cover a discrete teaching within the art, and wherein their length is derived primarily from tables. Columns 1-20 are cited primarily as an overview of Ben-Shaul. General Organization and Data Flow (col. 20, line 65 - col. 35, line 10) is concerned with the organization and flow of served content. General Specifications and Operating Conditions (col. 37, line 30 - col. 40, line 55) is concerned with responding to online changes, and includes sections on Site View Functionality and URL Swapping, and Example Applications of URL cited (latter not cited). The final categories, Resource Transformation and HTTP and Protocol Redirection (col. 41, line 10 - col. 42, line 5) complete the development of hyperlink maps and behavioral changes. Each section is clearly labeled, such that a reviewer may easily determine the information in each section.

Despite the Examiner's efforts in describing these passages, Applicants are still unclear as to the relevance of these sections to the specific language of the claims. Applicants claims are not directed to general concepts. Moreover, whether or not Applicants claimed invention and the teachings of Ben-Shaul share certain general concepts is not relevant to the issue of patentability, which is based upon the specific claim language.

The Examiner further asserted in the seventh enumerated paragraph on page 3 of the Second Office Action the following:

Applicant argues that examiner does not expressly disclose endpoint directives, or annotating said served content with endpoint directives (P. 3). The examiner has interpreted endpoint directives as added commands inserted into the hyperlink, such that the behavior is modified. The usage of particular language is not required, as the examiner may apply similar functionality with different labeling. If the applicant has a different definition of the phrase, he may raise it in remarks of this application.

At the outset, Applicants note that the Examiner's "claim construction" is incomplete. As claimed, the "served content" is annotated. Moreover, the Examiner assertion that "such that the behavior is modified" is ambiguous as to what "behavior" the Examiner is referring to. In this regard, Applicants note that claim 1 specifically recites that "hyperlink behavior referenced by said directives" is modified.

Claim 1

In an attempt to further clarify the Examiner's statement of the rejection as to claim 1, the Examiner asserted the following on page 4 of the Second Office Action:

For claim 1, Ben-Shaul teaches a method (abstract) for processing off-line interactive content (col. 1, line 1 - col. 20, line 65; col. 66, lines 15-20) in a dynamic system with variable addressability (Figs. 1-2), the method comprising the steps of:

- a. Serving content for caching (col. 22, lines 15-50) in a client device (Fig. 3, #30; regional edge server);
- b. Generating a pathway navigation map (PNM) for said served content; and,
- c. Annotating said served content with endpoint directives (CDML; col. 23, line 50 - col. 24, line 50; col. 33, lines 60-65) for modifying hyperlink behavior referenced by said directives in said cached content (col. 21, lines 5-35).

Upon reviewing the Examiner's revised statement of the rejection, notably absent from the Examiner's analysis is an identification of where Ben-Shaul identically discloses the claimed "generating a pathway navigation map (PNM) for said served content." On this basis alone, without need to refer to any other claim language, the Examiner has failed to establish a *prima facie* case of anticipation.

Another notable error in the Examiner's statement of the rejection is the Examiner's failure to properly distinguish between a server (including an edge server) and a client. Ben-Shaul clearly recognizes the differences between servers (e.g., web server, edge server) and a client (see, e.g., Figs. 8 and 9). However, with regard to the claimed "client device," the Examiner refers to reference numeral 30 in Fig. 3, which is a regional edge server (column 21, line 7). The Examiner's reference to column 23, line 50 through column 24, line 50 regards the interactions between the origin servers and the edge servers (see column 23, lines 49-53). As such, Applicants are unclear as to the relevance of these teachings to the cached content in the client device.

The Examiner's citation of column 21, lines 5-35 merely describes that requests by a client 14 may or may not be redirected to a regional edge server 30 or the origin site 10. Absent from this teaching, however, is (i) a discussion of cached content (i.e., content cached in the client device); (ii) hyperlink behavior referenced by the directives; and (iii) modifying the hyperlink behavior. Moreover, although the Examiner relied upon "CDML" to teach the claimed "annotating said served content with endpoint directives," a mention of CDML is absent from the Examiner's cited passage of column 11, lines 5-35, which states the purposes of the endpoint directives (i.e., "for modifying hyperlink behavior referenced by said directives in said cached content").

Therefore, after reviewing the Examiner's new statement of the rejection as to claim 1, Applicants are bolstered in their belief that Ben-Shaul fails to identically disclose the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102.

Although the Examiner referred to column 41, line 10 through column 42, line 5 to teach one of the recited group of endpoint directives, the Examiner did not identify what specific member(s) of the Markush group the Examiner is alleging this passage teachings. Applicants also note that the Examiner has not even addressed any of the limitations recited in any of the other the dependent claims.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1, 4, 6, 8-9, 11, 14, and 16-17 under 35 U.S.C. § 102 for anticipation based upon Ben-Shaul is not viable and, hence, solicit withdrawal thereof.

CLAIMS 2, 4-5, 7, 10, 12-13, AND 15 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BEN-SHAUL IN VIEW OF MASLOV, U.S. PATENT NO. 6,842,755

On pages 3 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Ben-Shaul in view of Maslov to arrive at the claimed invention. This rejection is respectfully traversed.

On page 3 of the First Office Action, the Examiner stated the following:

Ben-Shaul does not expressly disclose how to best develop the hyperlink map. Maslov teaches a method and system (abstract) of developing document trees based on page hierarchies (col. 1, line 1 - col. 8, line 5; col. 10, lines 10-35), wherein modifications based on depth and reconciliation of ambiguities are performed (col. 8, line 5 - col. 10, line 10).

Applicants incorporate herein, as also applying to the present rejection, the arguments previously presented with regard to the Examiner's rejection based upon Ben-Shaul. Specifically, the

Examiner has failed to specifically identify, within the applied prior art, teachings corresponding to the claimed elements.

The Examiner's alleged rationale to modify Ben-Shaul in view of Maslov is so that "documents may be retrieved even as the location of documents shifts." Applicants, however, are unclear as to how this would have realistically impelled on having ordinary skill in the art to modify Ben-Shaul in view of Maslov.¹ As described by Maslov, allows for dynamically generated documents (with dynamic online addresses) to be retrieved. However, this is the same problem being addressed by Ben-Shaul. Thus, the problem allegedly solved by Maslov has been addressed by Ben-Shaul, and therefore, one having ordinary skill in the art would not have been realistically impelled to modify Ben-Shaul in view of Maslov. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 2, 4-5, 7, 10, 12-13, and 15 under 35 U.S.C. § 103 for obviousness based upon Ben-Shaul view of Maslov is not viable and, hence, solicit withdrawal thereof.

¹ See the non-precedential opinion of *Ex parte Rinkevich*, Appeal 2007-1317 ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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